

Remarks

Applicant respectfully requests reconsideration and allowance of the present application in view of the claim amendments and remarks below.

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. §102(e) as being unpatentable over US Patent Application No. 2003/0050109 (Caro et al.). Claims 9 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent Application No. 2004/0266514 (Penrice).

Independent claims 1, 14, and 18 are amended herein to more patentably define and distinctly claim certain aspects of the method and apparatus according to embodiments of the invention. In particular, as amended herein, the method of claim 1 calls for conducting an instant win game in combination with a base wagering game. A base wagering game entry and wager are received from the player. The base wagering game entry comprises a first set of player selected or randomly generated game indicia. An instant win game wager is also received from the player. A game theme indicator is stored, as well as a plurality of instant win game outcome display themes. The instant win game themes are unrelated to the theme of the base wagering game. For example, the base wagering game may be a KENO game, whereas the instant win game theme may be a poker related game. The outcome of the instant win game is determined for the player, with the instant win game being independent from the base wagering game entry such that the instant win game is not dependent upon or a function of the first set of game indicia. The outcome of the instant win game is displayed to the player as a second set of game indicia that is unrelated to the theme of the base wagering game. The second set of game indicia is identifiable with one of the plurality of instant win

game outcome display themes, with such theme being determined by the stored game theme indicator. For example, the stored game theme indicator may dictate that the instant win game has a poker display theme (with the poker display theme being one of the stored themes). In this case, the second set of game indicia may be a hand of poker cards, or the like, that are readily identifiable with the power theme. Finally, the method of claim 1 calls for awarding the player an instant win game prize corresponding to the outcome of the instant win game.

The gaming system of independent claim 14 and terminal unit for conducting an instant win game in combination with the base wagering game of independent claim 18 have been similarly amended to reflect the amendments made to claim 1.

It is respectfully submitted that each of the independent claims are allowable over Caro '109 alone or in combination with any other reference of record. Caro '109 describes a system and method wherein the player has an option of playing an instant game, as well as a future lottery game. However, the instant game of Caro '109 is dependent upon, and is a function of, the first set of game indicia that is selected by the player. For example, as described at paragraph 48 of the reference, the instant game involves matching the player-selected numbers from the first set 26 with a randomly generated second set of numbers 30. The second set 30 is produced from the available field of numbers by a random number generator. The player's set 26 and randomly generated set 30 appear on the given ticket and, as explained in paragraph 49 of the reference, matches for the instant game are determined by the player examining the ticket to determine if any of the numbers in the first set 26 match the randomly generated numbers in the second set 30. This concept is clearly illustrated in Fig. 2A

wherein the first set of numbers 26 and second set of numbers 30 are displayed. In the illustrated embodiment, two of the player selected numbers (7, 8) match two of the numbers in the randomly generated set 30. Accordingly, the instant win game of Caro '109 is completely dependent upon the player's selection of numbers for the base wagering game. The outcome of the instant win game in Caro '109 is a function of the first set of player selected indicia.

Also, because the instant win game and base wagering game in Caro '109 are interrelated, it cannot reasonably be asserted that the second set of numbers 30 are unrelated to the theme of the base wagering game. Whatever the theme of the base wagering game is, the second set of numbers 30 is obviously related to the theme. Caro '109 does not describe or suggest of an instant win game that has a completely unrelated theme as compared to the base wagering game, with the second set of game indicia being completely unrelated to the first set of game indicia and identifiable with the theme of the instant win game. For example, the base wagering game may be a KENO, LOTTO, or bingo game, whereas the instant win game may have a poker related theme. The second set of game indicia would be identifiable with the poker theme and may be, for example, a poker hand, or the like.

Caro '109 also does not disclose or suggest of a method or system wherein a plurality of instant win game themes are stored that are unrelated to the theme of the base wagering game, with the actual theme for any instant win game being determined by a game theme indicator. According to the Caro reference, although a number of game themes may be stored, the themes relate both to the base wagering game and the instant win game alike. With the present claims, the theme of the instant win game

is determined by a stored game theme indicator that dictates the theme from a plurality of themes that are unrelated to the theme of the base wagering game.

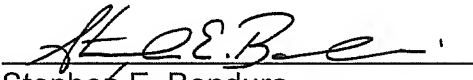
Accordingly, it is respectfully submitted that independent claim 1 is allowable over Caro '109, and that dependent claims 2 through 13 are allowable for at least the reasons claim 1 is allowable.

Independent claims 14 and 18 are allowable over the combination of Caro '109 and Penrice '514. Penrice '514 does not remedy the deficiencies discussed above with respect to the base reference Caro '109, and thus independent claims 14 and 18 are allowable for essentially the reasons set forth above with respect to claim 1. Claims 15 through 17 depend from claim 14 and are thus allowable for at least the reasons claim 14 is allowable. Likewise, claims 19 and 20 depend from claim 18 and are allowable for at least claim 18 is allowable.

For at least the reasons discussed above, Applicant respectfully submits that the claims patentably define over the cited references. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Should any issues remain after consideration of this amendment, then the Examiner is invited and encouraged to telephone the undersigned. If any fee not accounted for above is required for entry of this Amendment or papers filed herewith, authorization is hereby granted to charge such fee to Deposit Account No. 04-1403. If any petition is required for entry, such petition is hereby made and any associated fees may also be charged to our deposit account.

Respectfully submitted,

DORITY & MANNING, P.A.

By:   
Stephen E. Bondura  
Registration No.: 35,070

P.O. Box 1449  
Greenville, SC 29602-1449  
(864) 271-1592  
fax (864) 233-7342